

**Remarks**

The present amendment is in response to the Office action dated May 31, 2007, rejecting claims 42-54. Claims 42 – 56 are pending in the present application, with claims 42, 48, 54, and 55 being the independent claims and claims 55 and 56 being new claims. By way of this amendment, claims 42, 48, and 54 have been amended. Reconsideration and allowance of pending claims 42-56 in view of the following remarks are respectfully requested.

**A. Rejection of Claims 42, 44-45, 48, and 50-51 Under 35 USC § 102**

In the Office Action, Claims 42, 44-45, 48, and 50-51 are rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent No. 5,893,075 (Plainfield). Applicant respectfully submits that Plainfield does not teach every element of the claims as set forth in the pending independent claims 42 and 48 because Applicant has incorporated the limitations of claim 54 into claims 42 and 48. For the same reason claim 54 is not anticipated by Plainfield, neither are claims 42 and 48 and their respective dependant claims.

**B. Rejection of Claims 42, 48, and 54 Under 35 USC § 102**

In the Office Action, Claims 42, 48, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,793,972 (Shane). Applicant respectfully submits that Shane does not teach every element of the claims as set forth in the pending independent claims 42, 48, and 54 as follows.

In general, Shane generates direct mail and sends it to all appropriate recipients in a database. The direct mail includes an Internet link. If the recipient follows the link, the system generates a web page and monitors the user's interaction with the web page. The system in Shane may send follow up direct mail depending on the user's interaction with the web page (See, Shane, at Figures 2 and 3 for example).

Shane does not anticipate independent claim 42 because independent claim 42 includes “a scheduling module configured to manage a calendar of events” for a service provider, including scheduling new appointments and canceling existing appointments, the scheduling module further configured to identify an event on said calendar of events pertaining to a first client,” and “a merge

module configured to create a personalized promotion comprising a personalized message, the identified event on said calendar of events, and a reference providing network access to the scheduling module, the merge module further configured to address the personalized promotion to the first client at the network contact address for said first client.”

Shane does not anticipate independent claim 48 because independent claim 48 includes “merging the personalized message with a reference providing network access to a scheduling module that manages a schedule of events for the service provider, wherein the personalized message and the reference comprise a personalized promotion.” Shane does not anticipate independent claim 54 because independent claim 54 includes “searching a service provider database containing a plurality of client profiles for an event pertaining to a client,” and “composing a personalized message to the client pertaining to the event including examining the content criteria set for the client.”

Although the language in claims 42, 48, and 54 differ slightly, in general, Shane fails to send direct mail based upon anything except the fact that the recipients are listed in a database. Shane does not calendar events or send promotions based upon events in the calendar. Instead, Shane sends a mass mailing and if a person responds by visiting the website, it may determine their interests. For example, if a user interacts with the site such that it indicates that they like “trains”, an additional direct mail may be generated with links associated with trains. (See, Shane at Figure 3).

Nowhere in Shane is “a scheduling module,” a “calendar of events,” or a promotion that is generated based on the calendared events. For at least that reason, Shane does not anticipate independent claims 42, 48, and 54.

Additionally, claim 54 adds the limitations of “monitoring the sending of the personalized promotion,” and “generating an invoice based on the monitoring of the sending of the personalized promotion.” Nowhere in Shane is there a teaching, suggestion, or description of monitoring the sending of the message and using the monitoring step for billing purposes. For that additional reason, claim 54 is in a condition for allowance.

The remaining dependent claims 43-47 and 49-53 depend from claims 42 and 48 so Shane does not anticipate those claims either. Therefore, Applicant respectfully requests that a notice of allowance be issued with respect to claims 42-54.

**C. Rejection of Claims 43, 49, 46-47, and 52-54 Under 35 USC § 103**

In the Office Action, Claims 43, 49, 46-47, and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plainfield.

The Office Action states that Plainfield does not expressly disclose generating a holiday greeting, an appointment, or a prescription number but that public disclosures make this limitation obvious. This rejection is traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

**1. Suggestion or Motivation to Modify**

In the Office Action, no motivation has been supplied for modifying Plainfield. The subject matter of the present claims is related to a computer implemented system for marketing the services of a service provider over a computer network. The Examiner states that Plainfield teaches such a system, except Plainfield does not disclose generating a holiday greeting, an appointment, or a prescription reminder. The Examiner further states that such a limitation is common practice, but no citation to a reference disclosing such common practice is identified.

There are very significant differences, however, between a holiday, birthday, and anniversary greetings, appointment reminders, and prescription reminders and a computer implemented system for marketing the services of a service provider over a computer network. Merely because a service provider sends out a holiday greeting for example, they would not be motivated to do so over a computer network, nor would they be motivated to provide a "reference that provides network

access to a scheduling module,” since such a reference takes place inside of a computer and merely sending a holiday card does not.

Furthermore, while sending holiday greetings may be commonplace, sending an appointment reminder and a prescription reminder is not. Specifically, the computer implemented system must first obtain the information about when the appointment is schedule in order to send out an appropriate reminder. Even more significantly different is a prescription reminder, which requires the computer implemented system to have information about the prescription, the prescribed usage, and the calculated consumption date for the prescription such that the prescription reminder can be sent at the appropriate time. Therefore, Plainfield in view of the official notice does not create a suggestion or a motivation to achieve the present claims.

## 2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. For example, Applicant claims a “reference that provides network access to a scheduling module.” Such a reference provides for a computer to automatically send out the promotion when the event occurs. A “holiday greeting, an appointment, or a prescription reminder” does not perform automatic notification as the computerized reference presently claimed. As such, merely receiving notice would be ineffective and not work because as a result of the notice, no action occurs, no reminder is sent, and the recipient receives nothing. Therefore, Plainfield in view of the official notice could not be reasonably expected to succeed.

Furthermore, the Examiner has provided no citation that identifies a reasonable expectation of success in sending an appointment reminder or a prescription reminder is not. Specifically, the Examiner has cited no disclosure in Plainfield teaching that information about when an appointment is scheduled is first obtained in order to send out an appropriate reminder. Even more deficient is the lack of any disclosure in Plainfield teaching that information about the prescription, the prescribed usage, and the calculated consumption date for the prescription such that the prescription reminder can be sent at the appropriate time. Therefore, Plainfield in view of the official notice could not be reasonably expected to succeed.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. In particular, the claims are directed toward a computer implemented system for marketing the services of a service provider over a computer network. The claimed system requires a database of client profiles where each client profile includes a network address for the client. The claimed system also requires a scheduling module that is configured to manage a schedule of events for the service provider and identify an event on the service provider's schedule of events that pertains to a first client.

The claimed system also requires a merge module (or a step of merging) that is configured to create a personalized promotion addressed to the first client at the first client's network contact address. The personalized promotion is required to include a personalized message, the identified event that pertains to the first client, and a reference providing network access to the scheduling module. The claimed system also requires a communication module that sends the personalized promotion to the first client via a communication network.

Plainfield does not teach the claim elements. For at least the reasons discussed with respect to the independent claims 42, 48, and 54 in the rejections under 35 U.S.C. § 102 (see subsections A and B), the independent claims are in a condition for allowance. Claims 43-47 and 49-53 are in a condition for allowance as well. Accordingly, since the combination of references does not include all the limitations of claims of the independent claims 42, 48, and 54 and their respective dependent claims, the Applicant requests that the rejection be withdrawn.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been

identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the cited references of record.

**D. New Claims 55 and 56**

New claims 55 includes the generation of the personalized promotion using the navigation history of the client in a client profile. New claim 56 includes steps for monitoring the sending of the message and using the monitoring step for billing purposes. New claims 55 and 56 are fully supported by the specification and do not add new matter.

Neither Shane nor Plainfield, alone or in combination, anticipate or make obvious new claims 55 and 56. Applicant respectfully requests that a notice of allowance be issued with respect to new claims 55 and 56.

**Conclusion**

Pursuant to the remarks set forth in this response, Applicant respectfully asserts that all pending claims are presently in condition for allowance and a notice of allowance for claims 42-56 is respectfully requested.

Respectfully submitted,  
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Dated: November 29, 2007

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